

No. 11,667

IN THE

United States Circuit Court of Appeals
FOR THE NINTH CIRCUIT

TODD C. FAULKNER,

Appellant,

vs.

JOHN T. GIBBS,

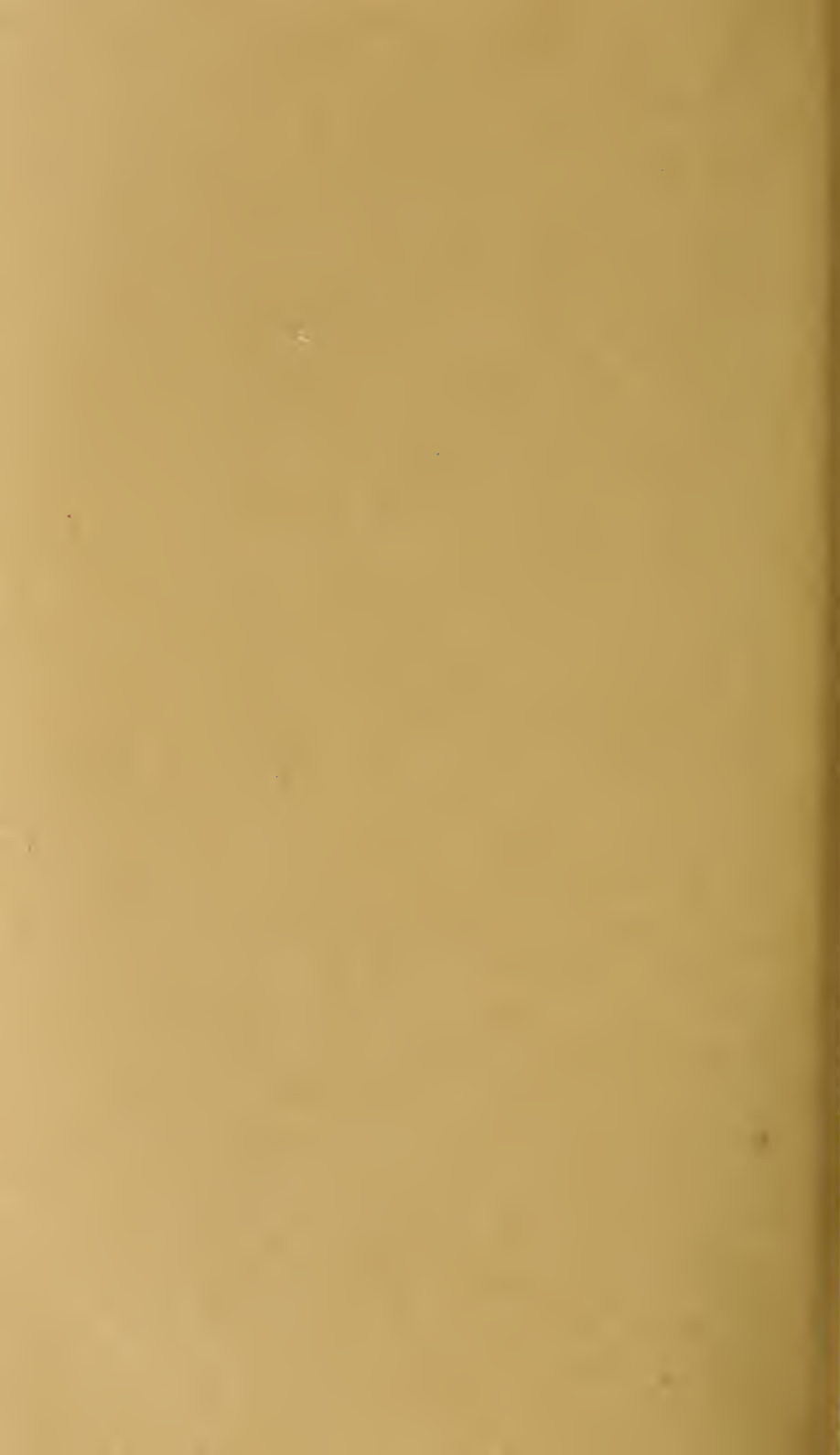
Appellee.

APPELLANT'S REPLY BRIEF.

ROBERT W. FULWIDER,
520 General of America Building, Los Angeles 36,

GERALD DESMOND,
614 Heartwell Building, Long Beach 2,
Attorneys for Appellant.

MAY 28 1948



TOPICAL INDEX

PAGE

I.

No presumption of validity attaches under F. R. C. P. 52(a) to the findings or conclusions of the trial court in this case.....	3
---------------------------------------------------------------------------------------------------------------------------------	---

II.

The decision in Gibbs v. T. Z. R. etc. is neither persuasive nor helpful in this case.....	5
--------------------------------------------------------------------------------------------	---

III.

Consent decrees and licenses cannot make an invalid patent valid	7
------------------------------------------------------------------------	---

IV.

The claims in suit are invalid; and are not infringed by either of the Fawn games.....	8
A. Appellee's brief does not discuss the game described by the claims in suit, but instead, what appellee terms the "essence" of his patent.....	8
B. Claim 3 is anticipated by Nakashima, is invalid for lack of invention, and is not infringed by either Fawn game....	10
(1) The first element of Claim 3 omitted in each Fawn game	13
(2) The second element omitted from Claim 3 by each Fawn game	15
(3) The new Fawn game additionally avoids Claim 3 by omitting the Gibbs supplementary win signal.....	17
C. Claims 6, 7 and 8 are anticipated by Prina, display no invention, and are not infringed by either Fawn game.....	20

D. Claims 9 and 10 are invalid for ambiguity and lack of invention, and are not infringed by either Fawn game....	22
(1) Claims 9 and 10 describe a game not taught by the Gibbs patent	22
(2) Since Claims 6, 7 and 8 were held not infringed by the new Fawn game, Claims 9 and 10 likewise cannot be infringed since they contain the element of Claim 6 which the trial court found not to be present in the new Fawn game.....	23
(3) Claims 9 and 10 do not read on the old Fawn game, and if reconstructed as urged by appellee they still are not infringed.....	28

V.

Appellee's statement that Faulkner copied the Gibbs game is not supported by the evidence and is not material to this case.....	29
Conclusion	30

TABLE OF AUTHORITIES CITED

CASES	PAGE
Carter Oil Company v. McQuigg, 112 F. (2d) 273, 3 Fed. Rules Serv. 503	4
Equitable Life Assurance Society of the United States v. Irelan, 123 F. (2d) 462, 5 Fed. Rules Serv. 610.....	4
Gibbs v. T. Z. R. Amusement Corporation, 14 Fed. Supp. 597, 29 U. S. P. Q. 518.....	2, 5, 6, 7
Halliburton v. Walker, 67 S. Ct. 6, 75 U. S. P. Q. 175.....	12
United States v. Esnault-Pelterie, 303 U. S. 26, 36 U. S. P. Q. 212	3
White v. Dunbar, 119 U. S. 47.....	9
RULES	
Federal Rules of Civil Procedure, Rule 52(a).....	2, 3

No. 11,667

IN THE

United States Circuit Court of Appeals
FOR THE NINTH CIRCUIT

TODD C. FAULKNER,

Appellant,

vs.

JOHN T. GIBBS,

Appellee.

APPELLANT'S REPLY BRIEF.

Appellee's Brief is noteworthy principally for its avoidance of the real issues in this case. Nowhere in his statements or arguments does Appellee face the fact that the scope of a patent is determined by its claims. [See Law Points 1, 3 and 4, pp. 16, 17, 18, 19, Appendix to Appellant's Opening Brief.]

With respect to the footnote on page 1 of Appellee's Brief we state the following:

This case was filed in August, 1946, and Mr. Desmond, an attorney engaged in general practice, represented Appellant at that time. In September at Appellant's invitation, the attorneys for Appellee visited Appellant's place of business, inspected the two Fawn games he had there, and examined, photographed and sketched one of them, both inside and out. Only the exterior of the other game was observed. The attorneys for Appellee prepared and Appellant stipulated to, a description of the game examined, which material was used by Appellee on his motion for a preliminary injunction. In December Mr. Fulwider came into the case

Appellee deals largely in generalities and inferentially asks the Court to “read into” his claims various things to make them valid, and then to “read out” of the claims various other things to find infringement. He ignores numerous points made in our Opening Brief, and as to others he merely states a contrary position without assigning reasons therefor.

Appellee seeks to avail himself of Rule 52(a) of the Federal Rules of Civil Procedure (as all appellees with vulnerable cases do) and requests this Court to affirm the judgment below, if there is any shred of evidence at all in support thereof. This is of course contrary to the spirit of the rule and to the long line of cases construing the similar Equity Rule.

Appellee also leans heavily on the *T. Z. R.* case, the consent decrees and his licenses, but as will be pointed out later, none of these factors carry any weight in this case.

We will discuss in detail, but as briefly as possible, these various points raised by Appellee’s Brief.

for the trial. The issues were already framed except for the matter of the new Fawn game which was, at Appellant’s instance, later injected into the case. After Appellant’s Brief was filed it was discovered as the result of depositions on accounting that there were some differences between the above-mentioned game examined in detail by attorneys for Appellee and the one they had merely observed. Neither of the attorneys for Appellant had any knowledge of these differences prior to their said discovery. Appellee states that Appellant concealed the facts. Appellant states that there was no concealment and that Appellee’s attorneys could have examined the inside of the other game if they had so requested. Mr. Desmond, who was present at the inspection, has no recollection of any conversations concerning an examination of the other game, and Mr. Fulwider was not present, as he was not then in the case. We do not see that the matter is material in the slightest but submit the foregoing because Appellee for some reason has seen fit to mention the matter.

I.

No Presumption of Validity Attaches Under F. R. C. P. 52(a) to the Findings or Conclusions of the Trial Court in This Case.

A substantial portion of Appellee's Brief is devoted to the thesis that great weight should be attached to the Trial Court's Findings of Fact in this case. That portion of Rule 52(a) which is pertinent to this contention reads as follows:

"Findings of Fact shall not be set aside unless clearly erroneous, and *due regard shall be given to the opportunity of the trial court to judge of the credibility of the witnesses.*"

The first clause of the above sentence is often quoted, but the second clause is seldom included. While the two clauses are stated in the conjunctive, the second clause is really *explanatory* of the first.

It is submitted that if the words in Rule 52(a) "and due regard shall be given" were changed to read "*since due regard should be given,*" the sentence in question would better state the true equity rule long applied by the courts.

A proper application of Rule 52(a) was made by this Court in the case of *Stuart Oxygen Company, Ltd. v. Josephian*, quoted in Appellee's Brief at pages 30 and 31 thereof, in which case the Court examined the evidence for itself under the doctrine of *United States v. Esnault-Pelterie*, 303 U. S. 26, 36 U. S. P. Q. 212.

Construing a patent is essentially no different from construing any other contract, and where the bulk of the evidence consists of documents such as prior patents, photographs, drawings, depositions and the like, the Appellate

Court is not required to give any weight to the Findings of the Trial Court. This rule was followed by this Court in the case of *Equitable Life Assurance Society of the United States v. Irelan*, 123 F. (2d) 462, 5 Fed. Rules Serv. 610, where Judge Healy stated as follows:

“Since all testimony bearing on the circumstances antecedent to and surrounding her death was by *deposition*, the Finding of accidental death, while it is justly entitled to consideration, *has not the weight we would otherwise be obliged to concede to it*. This Court is in as good a position as the trial court was to appraise the evidence, and we have the burden of doing that. * * * as is well known, in the Federal courts where the testimony in equity or admiralty cases is by depositions *a reviewing court gives slight weight to the Findings*.” (Emphasis added.)

The same rule was well expressed by the Seventh Circuit Court of Appeals in considering the weight to be accorded to the Master’s Findings in the case of *Carter Oil Company v. McQuigg*, 112 F. (2d) 275, 3 Fed. Rules Serv. 503, in which decision Judge Evans stated:

“Where the question is one of veracity it is clear that the appellate court should give controlling weight to the trier of fact who saw and heard the witnesses. This is well established. *Where the testimony consists of documentary evidence and depositions*, a Master is in no better position to determine an issue of fact than a reviewing court. The District Court’s Finding on such evidence is likewise subject to free review, *unaffected by presumptions* which ordinarily accompany their Findings on controverted issues.” (Emphasis ours.)

and see the quotation from the *Stuart Oxygen Company* case on pages 30 and 31 of Appellee’s Brief.

No extrinsic evidence need be considered in the decision of this case. The whole record of the Trial Court is before the Appellate Court with ample illustrations and descriptions of the devices in question. There is no conflict between the parties with respect to the construction of the Gibbs and Fawn games. The case turns solely on the construction to be given to the claims in suit and to the showings of the prior art patents.

Thus this case comes squarely within the doctrine enunciated in the above-quoted cases, and particularly the *Stuart Oxygen* and *Nicholl* cases quoted in Appellee's Brief, to-wit, that the reviewing court is not bound by any presumptions of validity or correctness of the lower court's Findings or Conclusions.

The fact that Appellee here has found it necessary to so strongly urge the contrary view is a clear sign of weakness on his part.

II.

The Decision in *Gibbs v. T. Z. R. etc.* Is Neither Persuasive nor Helpful in This Case.

The Appellee lays great stress on the New York District Court case of *Gibbs v. T. Z. R. Amusement Corporation*, 14 Fed. Supp. 597, 29 U. S. P. Q. 518, decided in 1936, and seeks to draw a parallel between the facts therein and the facts of the case at bar. However, a careful reading of the *T. Z. R.* case shows that the facts were totally different, there being no real contention of non-infringement. The Court stated that:

"The Defendant's device is *so like* the Plaintiff's that little or no contention is made on the subject of infringement;"

This is obvious from the fact that *all* of the claims of the patent were in suit and were held to be infringed. Since claims 1, 2, 4 and 5 (not in suit here) were all specifically limited to relays, armatures and momentarily operated contact switches, it follows that the Defendants' game must have been practically identical to the Gibbs game.

The New York Court therefore was not called upon to interpret the Gibbs claims since even the narrowest ones were infringed. Likewise, Gibbs was not faced with the problem, as he is here, of having to mold his claims one way to find infringement and another way to make them valid.

When arguing the prior art, such as Nakashima for example, Gibbs in the *T. Z. R.* case could point to his relays and momentarily opened contact switches as distinguishing features, and since these same elements were in the *T. Z. R.* apparatus there was no need for Gibbs to ask the Court for a broad construction of his claims.

The *T. Z. R.* decision is not necessarily inconsistent with Appellant's position in this case, for it is thought that if Judge Byers had had the Fawn games and the *prior art cited in this case* before him, he would have found no infringement. Whether or not he would have found invalidity we cannot now say, although from the scarcity of good prior art cited and the tone of the decision it does not appear that the *T. Z. R.* case was very vigorously defended.

The only multiple-unit game patent mentioned by the Court in the *T. Z. R.* case was Irsch No. 1,433,888 which is so poor a reference that we did not even plead it in this case. This is the Irsch patent mentioned on page 8 of Appellee's Brief and is not to be confused with Irsch

1,458,884 used by Appellant herein as prior art. If Judge Byers had had the benefit of the Prina, Chester, Higuchi, Irsch 1,458,884, and Wallace patents, *all illustrating competitive games having the cut-off later used by Gibbs*, it is quite likely that he would not have been so impressed with the Gibbs game. Certainly his decision would have been written in quite a different vein since these prior art patents negative many of the advantages and novel features mistakenly attributed by the Court to Gibbs. It is felt that on the basis of this additional art Judge Byers would probably have held claims 6 to 10 invalid, and possibly claim 3 also.

Appellee also seeks to draw a parallel with the *T. Z. R.* case by inferring in his brief that because Faulkner permitted a Preliminary Injunction by default there is no real contention on the question of the infringement of the old Fawn game. However, this is clearly not the case as seen from our Opening Brief. If the obvious needs restating, we hereby affirm that we are most seriously and sincerely contending that the old Fawn game does not infringe!

III.

Consent Decrees and Licenses Cannot Make an Invalid Patent Valid.

Appellee relies strongly on the various consent decrees which he had heretofore secured and on his alleged commercial success. However, consent decrees are entitled to but little weight as they are merely evidence that the Defendants therein did not wish to go to the expense of a lawsuit.

With respect to the various licenses granted by Gibbs, it is admitted that he has had some commercial success,

but that success has not been such as to in any way affect the issues of this case.

Commercial success can only tip the scale in favor of validity when the evidence for and against the patent is evenly balanced, and then, only when the commercial success is phenomenal and the art has long been searching for a solution to the problem.

IV.

The Claims in Suit Are Invalid; and Are Not Infringed by Either of the Fawn Games.

A. Appellee's Brief Does Not Discuss the Game Described by the Claims in Suit, but Instead, What Appellee Terms the "Essence" of His Patent.

Appellee's contentions with respect to validity are epitomized by the wistful statement on page 20 of his brief that:

"he (Gibbs) can properly be found to have invented *something*." (Emphasis added.)

But Appellee studiously avoids reference to his claims in telling us what he allegedly invented.

Instead of discussing the invention defined in his claims, the Appellee expatiates on what he terms the "essence" of his invention and fashions a definition thereof that does not correspond to any claim in his patent.

In his discussion of validity Appellee infers that all of his claims include the cut-off circuit and states that in the Gibbs game the non-winners are cut-off "at the termination of a playing period *as determined by an electric time switch*." Both the inference and the statement are incorrect. Claim 3 does not recite the cut-off feature at

all, and there is no teaching whatsoever in the Gibbs patent of a time clock apparatus or method of play!

In his discussion of infringement the Appellee infers that all of his claims include a single ball, holes in the board, and the non-winner cut-off, but a reading of the claims shows this not to be true.

When discussing claims 6 to 10, Appellee borrows generously from the specification and drawings and ignores the prior art. In attempting to minimize the effect of the multiple-unit prior patents he states at page 14 that they

“are apparently relied upon by Appellant on the proposition that each of these patents provides an electric circuit open until a win has been made and that when there is a winner a light lights or a bell rings.”

This, however, is *only one of the features* for which these patents are cited. As clearly documented in our Opening Brief, each of these prior patents shows a *multiple-unit competitive game* in which when a win is made on one unit a signal is operated *and all of the other units are automatically disconnected*.

In relying upon what he terms the “essence” of the Gibbs invention instead of the claims, the Appellee asks this Court to read *certain things into* the claims to find validity and then to read *certain other things out* of the claims to find infringement. This has been condemned by the Supreme Court in very apt language in the case of *White v. Dunbar*, 119 U. S. 47, 51, as follows:

“Some persons seem to suppose that a claim in a patent *is like a nose of wax which may be turned and twisted in any direction*, by merely referring to the

specification, so as to make it include something more than or something different from, what its words express. The context may, undoubtedly, be resorted to, and often is resorted to, for the purpose of better understanding the meaning of the claim; *but not for the purpose of changing it and making it different from what it is.* The claim is a statutory requirement, prescribed for the very purpose of making the patentee define precisely what his invention is; and *it is unjust to the public, as well as an evasion of the law, to construe it in a manner different from the plain import of its terms.* This has been so often expressed in the opinions of this Court that it is unnecessary to pursue the subject further.” (Emphasis added.)

B. Claim 3 Is Anticipated by Nakashima, Is Invalid for Lack of Invention, and Is Not Infringed by Either Fawn Game.

Appellee infers on page 10 of his Brief that Appellant has shifted ground and is now urging additional patents as anticipatory of claim 3. This is not the case, however, as a simple inspection of our Opening Brief will reveal. Nakashima was urged at the trial and is still urged as anticipatory of claim 3. The other board-and-ball patents used against claim 3 go to show lack of invention.

The Prina patent was pleaded and is urged as anticipatory of claim 6 because this claim is not limited by its terms to a board-and-ball game, but comprehends any multiple unit game employing indicator lights.

Appellee seeks to minimize the prior art patents cited against claim 3 by stressing minor differences between the games therein disclosed and the Gibbs game. However, most of the points of difference mentioned by Appellee refer to features not included in the Gibbs claims.

For example, Appellee stresses that Nakashima and some of the other prior patents show single unit games utilizing a plurality of balls. However, claim 3 is only directed to a *single unit* and does *not* specify any number of balls to be used in the play. Claim 3 is totally silent as to what means is used to operate the annunciator contact devices. As a matter of fact, claim 3 does not even specify that the playing board has holes in it or that the contact devices are underneath the holes.

Further inconsequential points of difference are illustrated by Appellee's mention with respect to Hayashi that his playing board is inclined downwardly instead of upwardly and that the objects which he moves across the board roll in a zig-zag path. Again, however, attention is called to the fact that there is nothing in claim 3, nor for that matter in any of Gibbs' claims, specifying the tilt of the playing board or the path of the objects moved thereacross.

With respect to Esmarian the Appellee remarks that the only balls which are returned to the player for re-rolling are those which have not entered a pocket. But again it is to be noted that claim 3 says nothing about any balls passing through any pockets. Appellee also mentioned in this connection that Esmarian does not show an annunciator panel wherein horizontal, vertical or diagonal lines of lights can be energized to create a winner. But again we observe that none of the claims of the Gibbs patent specify either the number of lights in his annunciator panel or how they are arranged.

With respect to Nakashima Appellee makes the bald statement appearing at the top of page 24 that the "Nakashima game is entirely different." But the only

difference in so far as claim 3 is concerned between the Gibbs and Nakashima games is that Nakashima energizes his indicators by keeping his contact devices closed, whereas Gibbs energizes his indicators by relays which are operated by the momentary closing of his contact devices. This feature of the Gibbs game is defined in claim 1 (not in suit) as follows:

“a plurality of relays in the circuit of said indicators adapted to be energized when a ball is dropped through said apertures into engagement with said contacts, * * * whereby when each of said contacts has been momentarily operated by said ball, said relays and said indicators will be energized.”

Because of the above limitations in claim 1, it is not anticipated by Nakashima, but in claim 3 this structure is broadly stated (see claim outline on page 20 of our Opening Brief) as

(f) “*means* for energizing said indicators as the associated contact devices are operated.”

As was said in the *Halliburton v. Walker* case, 67 Supreme Court 6, 75 U. S. P. Q. 175, claim 3 uses

“conveniently functional language at the exact point of novelty.”

In the *Halliburton* case the penalty paid by the patentee was invalidity of his patent. A similar ruling is even more justified in this case since the broad words “means for energizing” read literally on Nakashima.

Our position with respect to Claim 3 is that when *literally construed*, it reads fairly and squarely, element-by-element, upon Nakashima (see pages 23 to 25 of our Opening Brief) *but not on either Faxon game*. By its

plain terms, claim 3 calls for two elements present in Nakashima but not present in either of the Fawn games. (There is also a third element missing in the *new* Fawn game which will be discussed later.)

Since there is no literal infringement of claim 3 by the old Fawn game, Appellee has been compelled to expand this claim by urging the doctrine of equivalents. But as expanded, claim 3 reads even *more clearly* on Nakashima.

(1) THE FIRST ELEMENT OF CLAIM 3 OMITTED IN EACH
FAWN GAME.

Claim 3 (see outline, page 20 of our Opening Brief) includes among other things:

(b) “a plurality of *contact devices*”;

(c) “a plurality of *indicators*”;

and

(f) “*means for energizing* said indicators as the associated *contact devices* are operated.”

These three elements of Claim 3 clearly describe the Gibbs type of game in which the contact devices (b) are momentarily closed to operate means (f) for energizing the indicators (c). Not only are the *contact devices* and *energizing means* thus separately stated as individual elements (b) and (f), but their individuality is accentuated by the fact that they are both mentioned in the same clause (f). This part of claim 3 can be rewritten for clarity as follows without in any way changing its meaning.

“Means (f) for energizing the indicators (c) as the associated contact devices (b) are operated.”

In order to find infringement in the old Fawn game, the Appellee argues that Faulkner's overbalanced switch is the equivalent of both elements (b) and (f) because, he says, Faulkner's switch remains closed to cause his indicator lamps to stay energized.

What the Appellee ignores is the fact that *Nakashima also keeps his indicator lamps energized by keeping his switches closed.*

The only difference between Faulkner and Nakashima is that the Faulkner switch stays closed by its own weight whereas Nakashima's switch is kept closed by the weight of the ball thereon. Obviously any construction of claim 3 which includes the Faulkner overbalanced switch as an equivalent *must also include the Nakashima switch as an equivalent*, and render claim 3 invalid.

On the other hand, if claim 3 is construed as the Patent Examiner undoubtedly intended, *i. e.*, as limited to separate electrical means for maintaining the indicators energized after the contact devices have been operated, then claim 3 is valid over Nakashima, but is of course still more clearly not infringed.

Still another incongruity appears from Appellee's contention that claim 3 reads on the Faulkner game, for by so doing, the Appellee of necessity adopts the Faulkner structure as his own in so far as the question of validity is concerned. In other words, when the Appellee argues that claim 3 includes the Faulkner overbalanced switch, he is, in effect, rewriting claim 3 to specify that the indicators are energized by contact devices which stay closed.

Since the only difference between Nakashima and Gibbs resides in the means for energizing the indicators, Gibbs

by adopting the Faulkner overbalanced switch as part of his claim argues that it was invention to substitute the overbalanced Faulkner switch for the switch of Nakashima.

It is apparent on the face of it that if Gibbs had presented an application to the Patent Office illustrating the Fawn mechanism, and had substituted the words "a plurality of overbalanced switches for energizing said indicators" in lieu of the present wording of claim 3, the Examiner would have promptly rejected the claim on Naskashima. Gibbs would never have convinced the Examiner that there was any patentable novelty in substituting his overbalanced switch in the Nakashima game otherwise described by claim 3.

And yet, in claiming infringement of claim 3 by the old Fawn game, Appellee asks this Court to rule that it was patentable invention to substitute the Faulkner overbalanced switch arm in the Nakashima game.

(2) THE SECOND ELEMENT OMITTED FROM CLAIM 3
BY EACH FAWN GAME.

In Appellant's Opening Brief (pp. 69, 70) we pointed out that element (g) of claim 3 is likewise omitted from each of the Fawn games since neither the old nor the new game has "an electric circuit common to all of said groups." In answer to this, Appellee states that he fails to follow our argument and that the Fawn game has a win circuit which is "comprehensive of" all of the groups. However, the claim does not say "comprehensive," it says "common," and on the face of it, one circuit cannot be common to a plurality of other circuits unless it is electrically connected or connectable thereto. This wording was inserted

in claim 3 by amendment to meet the objection of the Examiner, and Appellee is bound by said wording.

As Appellee mentions, the same *result* is achieved in the Gibbs game and the old Fawn game when a win is made, but this is not the test of equivalency. Appellant had a perfect right to accomplish the result of Gibbs by using *different means*, which he has done. A simple examination of the wiring diagram of the old Fawn game shows that Appellant's win circuit is not common to any of the annunciator light circuits as is the case in Gibbs.

The law was correctly stated in the *Mills Novelty* case quoted by Appellee on page 25 of his Brief in which case the Court said that patent claims are to be read in the light of the specification, *but are not to be expanded or limited thereby*. When this element of Gibbs is read in the light of the specification, it is clearly apparent that the word "common" (suggested by the Examiner) means "electrically connected or connectable" and does not include a mechanical arrangement such as present in the Fawn game.

It is therefore submitted that both the old and the new Fawn games avoid infringement of claim 3 by omitting (1) the separate energizing means of Gibbs, and (2) by not having a win circuit "common" to the group circuits.

Attention is also called to pages 26-32 of our Opening Brief which bring out clearly the fact that claim 3 besides being anticipated by Nakashima, is invalid as lacking invention over Nakashima and the other prior art patents. This defense was not mentioned in Appellee's Brief and hence we have nothing to reply to here on that score.

Attention, however, is particularly directed to the Wallace patent which shows ball rolling game units connected in the same fashion as Gibbs.

(3) THE NEW FAWN GAME ADDITIONALLY AVOIDS CLAIM 3 BY OMITTING THE GIBBS SUPPLEMENTARY WIN SIGNAL.

As above pointed out, *both* Fawn games avoid claim 3 by the omission of elements (f) and (g) thereof and hence do not infringe.

Additionally, as brought out in our Opening Brief (pp. 58-64), the *new* Fawn game *further avoids infringement* of claim 3 by completely omitting the last element thereof, to-wit:

“supplementary means for indicating a winning play when all of the indicators in one of said groups have been energized.”

As pointed out by Appellee on page 25 of his Brief, the old Fawn game had this element present in the signal lamps on top of the annunciator panels. However, the new Fawn game does *not have any signal lamps* and consequently this element is completely missing.

Appellee urges that the *supplementary means for indicating a win* in claim 3 must of necessity be something different from and broader than the “master signal” recited in claim 2 because, the Appellee states, claim 3 must be distinguishable from claim 2. However, even a cursory examination of claim 2 shows that it is much narrower in many respects than claim 3 without regard to the win signal element.

A fair reading and comparison of these two claims and a fair reading of the specification (see pages 60, 61

of our Opening Brief) leaves no doubt as to what Gibbs and the Patent Office had in mind when claim 3 was allowed. The last element of claim 3 obviously refers to a win lamp or other *means for signalling a win*, not only to the player of that particular game unit, but also to the other players and the operator.

Appellee has in his Brief finally committed himself to the *click and flicker*, *i. e.*, to the position that the *incidental click* of Appellant's transfer relay and the *momentary flicker* of the annunciator lights due to their power being shut off for the fraction of a second taken by the relay arm in moving from one position to the other, is the full equivalent of the *supplementary signalling means* of claim 3.

The familiar and well known rule of equivalents (see Law Point 7, Appendix, p. 23, Appellant's Opening Brief) is, that to be an equivalent, a device *must perform the same function in substantially the same way* (not just a *similar* function in a *similar* way as stated by Appellee).

However, even by Appellee's own rule of equivalency stated on page 26 of his Brief, that the *purpose, result and means* must be similar in order to have an equivalent, there can be no infringement of claim 3 by the new Fawn game.

Appellant's relay is *solely for the purpose* of setting up a transfer circuit, so that when the *time clock subsequently opens the main power switch to all the game units*, the annunciator lights on the winning game unit will not be shut off. The relay has no purpose or function whatsoever of indicating a win. Even a cursory examination of Exhibit J [R. 535] and a reading of the description of the new Fawn game at pages 10-13 of

the Appendix of Appellant's Opening Brief shows this to be the fact.

Likewise, the *result* is not the same (or even similar) since the normal click of the relay and momentary flicker of the annunciator lights incident to the operation of the relay are not at all comparable to the continuous glow of a signal lamp which notifies not only the winning player but also all of the other players and the operator that a win has been made.

Appellee's own expert, Mr. Burke, testified at R. 123 with respect to the "click" that:

"I doubt if it could be heard by any of the players, except the one above it."

and further at R. 141, we find the following:

"Q. The average relay that they put in a game of that type would be bound to have a little click? A. (By Mr. Burke): That is correct."

To say then, that in a room where there are sixteen game units being played by sixteen people rolling balls which are dropping into holes and causing lights to come on, the incidental click of a relay on one game unit which can only be heard by that player, and a momentary flicker of its lights incident thereto accomplishes the result of *signalling a win* to the sixteen players and the operator (behind the games where he cannot see the flicker) is ridiculous on its face.

Lastly, the *means* are obviously not the same. There is absolutely no similarity between a *relay located under the game board* and a *signal lamp located on the top of the annunciator panel*.

For Appellee to argue otherwise is to do violence to the plain and simple meaning of the words of the claim, and the description in the specification.

The click which Appellee contends amounts to a signal is, of course, normal to any relay unless it is a very expensive and complicated one. Consequently, any game employing multiple units and relay cut-offs, such as Prina, Chester, Wallace and Higuchi, of necessity will have a slight click as the relay closes and a flicker of the lights in circuit therewith. For example, the lights of Prina will flicker, and a click will be heard when the win relay is operated.

This matter of the click and the flicker is dealt with at pages 62-64 of Appellant's Opening Brief to which attention is referred for a further discussion. However, before we leave this point, the Court's attention is respectfully called to the further fact that claim 3 calls for "*supplementary*" signalling means. Appellant's relay is not, in any sense "*supplementary*," since it is the essential part of the preceding element of claim 3. The Appellee still has not told us how the relay can be *supplementary to itself*. Obviously it cannot be.

C. Claims 6, 7 and 8 Are Anticipated by Prina, Display No Invention, and Are Not Infringed by Either Fawn Game.

Appellee has completely ignored Appellant's detailed comparison of claim 6 with the Prina patent set forth at pages 37 and 38 of Appellant's Opening Brief. Furthermore, Appellee makes no argument in support of his naked assertion that claim 6 is valid. The entire discussion of claim 6 in Appellee's Brief is confined to two short paragraphs at the bottom of page 26 and the top of page 27

of his Brief, wherein he concedes that "in a general way" Appellant's position that claim 6 is merely a group of the claim 3 units is correct.

As pointed out in our Opening Brief, claim 6 is not only anticipated by Prina but is also invalid for lack of invention, since it is not invention to merely interconnect a number of the Nakashima games of claim 3 by means of the circuits disclosed in Prina, Chester, Wallace, Irsch and Higuchi. This is particularly true since Wallace shows the use of a momentarily closed switch of the Gibbs type in a competitive board game. (Gibbs was operating a Wallace game when he conceived his own game.) It could not be invention to substitute the annunciator panel of Nakashima in the competitive board game of Wallace. This is not the caliber of thinking that amounts to invention under the law.

It is apparent that since neither of the Fawn games infringes claim 3, they likewise cannot infringe claim 6 which is merely a group of claim 3 units put together.

The Trial Court held that the new Fawn game did *not* infringe claim 6, and it should also have held that the old Fawn game did not infringe.

Since there is no infringement of claim 6 there cannot, of course, be any infringement of claims 7 and 8 dependent thereon. In this connection it is interesting to note that Appellee finds the "supplementary signal" of claim 7 in the *signal lamp* on the top of the old Fawn game, although when discussing claim 3 he contends that the absence of this lamp is immaterial.

Appellee's observation with respect to claim 8 is clearly erroneous because in *neither* Fawn game is there a master switch under the control of the operator. In the Gibbs

game the master switch 68 (see Fig. 10) has to be operated each time the game is completed. No similar structure is found in either the old or new Fawn game. In the new Fawn game particularly, it will be noted that the starting and stopping of the game is governed by the time clock.

With respect to validity, the additions of claims 7 and 8 to invalid claim 6 are not sufficient to save these claims. This entire set of claims, *i. e.*, 6, 7 and 8, stand or fall together.

D. Claims 9 and 10 Are Invalid for Ambiguity and Lack of Invention, and Are Not Infringed by Either Fawn Game.

(1) CLAIMS 9 AND 10 DESCRIBE A GAME NOT TAUGHT BY THE GIBBS PATENT.

As pointed out at pages 45 and 46, and again at pages 74 and 75 of Appellant's Opening Brief, the elements of claim 9 are not only inconsistent with each other, but actually describe a game *different from* the Gibbs game. Appellee does not deny this fact. He cannot. His only answer to this *fact* is that the claims have not been so held in the past.

In the Gibbs game as disclosed in his specification and drawings and as *claimed in all but claims 9 and 10*, when five lights in any row (a group) on one of said game units have been energized, the remaining game units are thereupon disconnected.

But what claim 9 says, is that:

- (1) the win signal circuit is held open until five lights in a row (a group) on *each* game unit have been energized.

and

- (2) when all 25 of the lights of any game unit have been energized, the win signal circuit will be closed,

and then

- (3) the non-winning units will be disconnected.

Under the clear holdings of the Supreme Court in the cases cited in Law Point 2 of our Opening Brief, Appendix, pages 17 and 18, these ambiguous and invalid claims should not longer be allowed to plague the public.

- (2) SINCE CLAIMS 6, 7 AND 8 WERE HELD NOT INFRINGED BY THE NEW FAWN GAME, CLAIMS 9 AND 10 LIKEWISE CANNOT BE INFRINGED SINCE THEY CONTAIN THE ELEMENT OF CLAIM 6 WHICH THE TRIAL COURT FOUND NOT TO BE PRESENT IN THE NEW FAWN GAME.

Appellee argues that the time clock in the new Fawn game is merely an accessory and does not change the method of play. This is the argument advanced by Plaintiff at the trial with respect to claim 6 which the Trial Court expressly overruled.

The Trial Court found that the new Fawn game, because of its time clock, *had a different method of play and accomplished a different result from the Gibbs game.* This is a complete answer to Appellee's statement on page 3 of his Brief that "the method of play was the same as before."

Appellee takes issue with our statement that the new Fawn game is not competitive. However, again the answer to this contention is found in the Trial Court's remarks at the close of the trial where *the Court said that*

the time clock made the game non-competitive and hence removed it from the scope of claim 6.

The Appellee has not appealed these rulings of the Trial Court and they therefore stand admitted.

How then, in the face of the Trial Court's decision that the new Fawn game achieved a *different result* in a *different manner* from the Gibbs game, can the Appellee now seriously urge that the new Fawn game infringes claims 9 and 10?

The failure of the Trial Court to include these claims with claims 6, 7 and 8 as not infringed was clearly the result of a misapprehension of the facts and was probably due to the fact that in arguing vigorously against claim 6, we only touched briefly on its counterpart claim 9.

Claim 9 and its dependent claim 10 are, like claim 6, directed to a plurality of individual game units electrically interconnected. In other words, these claims are (to the extent that they are intelligible) directed to the entire Gibbs game as illustrated and described in his specification.

As set forth on page 56 of our Opening Brief, element (e) of claim 6 with its subdivision (1) broadly covers the same subject matter as elements (d), (e), (f) and (g) of claim 9. It is true as stated by Appellee that claim 9 does not specifically include element (e-2) of claim 6 that the lights on the winning game shall be kept illuminated. However, this had nothing to do with the Trial Court's decision.

What the Trial Court found, and what is an obvious fact, is that the new Fawn game does not have any part of elements (e) (e-1) of claim 6, which read as follows:

“means whereby when all of the indicators in any group of any of said units have been operated to complete a winning play the indicators on all of the units except the winning unit will be deenergized.”

It would seem too apparent for argument that element (g) of claim 9 which states:

“means controlled by the closing of the signal circuit of the winning unit for discontinuing the signals and opening the circuit of the indicators of all other units”

refers to exactly the same structure as defined in element (e, e-1) of claim 6.

Appellee does not actually state that these elements refer to different structure in the Gibbs game. He merely argues that because claim 6 recites additionally that the indicators of the winning unit remain energized whereas claim 9 only recites this inferentially that claim 9 is narrower than claim 6.

But this is no answer to the clear fact that claim 9 contains the exact element of claim 6 which the Trial Court found to be lacking in the new Fawn game. On R. 266 we find this clearly stated as follows:

“The Court (to Mr. Huebner): I don't quite get the trend of your thought. It seems to me that the latter part of that claim, the wording would not be read on the altered game, as you call it, the new game, because there is no deenergization, deenergization

does not occur, because the game goes on. In other words, in the second game, if the person win, the play goes on until the clock strikes, while in your game automatically the other players are left out in the dark, as it were, and the game stops.

“For that reason, I can’t see how this latter part can be said to be anywhere read upon it. If I understand correctly, the word ‘deenergized’ means that the electrical current which had operated on these units is off, or momentarily it does not have any effect.”

What the Court said at the trial and what the Court ruled in its decision (which is now final), was that the time clock made the new Fawn game non-competitive because the non-winning units were not disconnected when a win was accomplished but remained operative until the time clock, at some later period, shut down the game.

Appellee by tortuous reasoning tries to distinguish between claims 6 and 9 by attaching particular significance to the word “controlled” occurring in claim 9. We are told that the words “controlled by” in claim 9 really mean “conditioned by,” and that the *means* in claim 9 control “to the extent of *severing the circuits* and thus conditioning the win circuit to remain energized, the others to be de-energized when the time switch is thrown.” *This, however, is not a correct statement.*

When a win is accomplished in a unit of the new Fawn game, the annunciator lights on that game unit are transferred to an auxiliary power circuit so that when the main power line is subsequently cut by the time clock, the winning game unit will not be affected thereby. Neither the win circuit nor the transfer circuit of the winning game unit have anything to do with cutting off the other games.

It is not a fact, as stated by Appellee on page 28 of his Brief, that "the circuit which opens the non-winner circuits is prepared or conditioned by the win circuit."

The non-winner circuits are only opened by the time clock circuit and are not prepared, conditioned, controlled or affected in the slightest by any circuit in the winning unit. Appellee very evidently has forgotten how the new Fawn game operates.

Attention is respectfully called to the detailed description of the construction and operation of the new Fawn game which appears in pages 10-13 of the Appendix of Appellant's Opening Brief. As therein stated, a win on any game unit does not in any way affect the operation of the other games, it does not disconnect them, it does not prevent the other players from continuing their play, and it does not control, modify or affect the time clock or any outside circuit.

There are no means controlled or conditioned by the closing of a signal circuit of the winning unit for discontinuing or shutting off the other playing units. The other playing units are shut off solely by the operation of the time clock. The argument of Appellee to the contrary is in plain disregard of the facts.

Appellee asserts that both the old and new Fawn games infringe claim 10 which calls for an *audible* signal. Appellee does not say wherein he finds this audible signal but he must be referring to the click of the win relay previously discussed. Obviously, the click of the relay is not the equivalent of the win bell contemplated in claim 10. The court's attention is additionally called to the fact that the actual wording of claim 10 calls for an

"audible signal *commonly connected with all of said units.*"

In the Gibbs game this is the bell 69 which is commonly connected to all units and rings when *any* game unit wins.

Even if the click of the Fawn game relays could be said to be an audible signal, still they would not infringe claim 10 because it calls for that signal being *commonly connected to all of the units*. Obviously, the win relay in any individual Fawn game unit is not connected to any other unit and has nothing to do with the other units.

(3) CLAIMS 9 AND 10 DO NOT READ ON THE OLD FAWN GAME, AND IF RECONSTRUCTED AS URGED BY APPELLEE THEY STILL ARE NOT INFRINGED.

This point, which was fully discussed on pages 74, 75 and 76 of our Opening Brief, is not even mentioned in Appellee's Brief. Appellee again contents himself with the naked statement that claim 9 is infringed.

In addition to the above-noted pages of our Opening Brief the Court's attention is directed to the discussion earlier in this article under Section D-1 where we analyzed the ambiguities of claim 9. The game described by claim 9 is entirely foreign to the Faulkner games.

To the extent that claim 9 is intelligible, it merely recites a plurality of claim 3 game units and is invalid and not infringed by either of the Fawn games for the reasons heretofore advanced in discussing claims 6, 7 and 8.

V.

Appellee's Statement That Faulkner Copied the Gibbs Game Is Not Supported by the Evidence and Is Not Material to This Case.

The Appellee is still urging that Faulkner is guilty of something or other because he saw some marble games in Loeff's establishment in Long Beach and set out to build a game that was similar thereto. (Loeff then had no connection with Gibbs.) There is nothing in the record to show that Faulkner or Hatherell or any employee of Faulkner had any access to the operative parts of the Loeff games, nor is there any evidence in the case whatsoever to show that the Loeff game was a copy of the Gibbs game.

In answer to Appellee's contentions, attention is called to the testimony of Wiser quoted on pages 14 and 15 of the Appendix of our Opening Brief, and to our discussion of this issue on pages 76 to 78 of the Brief. In so far as the Loeff game was concerned Wiser testified that he never saw the inside of it and that they merely set out to copy the *method of play*. Gibbs' patent does *not* cover the method of play.

Appellee seeks to draw a parallel between this case and the facts in the *Stuart Oxygen* case and makes the flat statement that Faulkner deliberately copied the Gibbs game apparatus. *Such is not the fact.* There is no showing in this case that either Faulkner or Hatherell had any knowledge whatsoever as to the essential construction of the Gibbs apparatus, or the Loeff apparatus either for that matter.

Conclusion.

By way of summary, reference is made to the Topical Index hereof, which succinctly states our position, which is of course stated in more detail in our Opening Brief. We do not recede from any point raised in our Opening Brief.

It may be that Gibbs made an invention such as described in the narrow claims not here in suit. However, it is abundantly clear that the claims here being sued upon are invalid unless narrowly construed. Furthermore, no matter what construction is placed upon the claims they are not infringed by either of the Fawn games.

Respectfully submitted,

ROBERT W. FULWIDER,

GERALD DESMOND,

Attorneys for Appellant.